

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

PC811.02 / 31132.227

I hereby certify that this correspondence is being transmitted to the
United States Patent and Trademark Office via EFS-Web on

Application Number

Filed

10/776,754

02/11/2004

First Named Inventor

Lukas Eisermann

Art Unit

3738

Examiner

Schillinger, Ann M.

March 5, 2007
Signature Debbie LudwigTyped or printed
name Debbie LudwigApplicant requests review of the final rejection in the above-identified application. No amendments are being filed
with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record. 37,713

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Brandi W. Sarfatis
Signature

Brandi W. Sarfatis

Typed or printed name

214-651-5896

Telephone number

3/5/07
DateNOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.☒

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	
Lukas Eisermann	§	Confirmation No. 3616
	§	
Serial No.: 10/776,754	§	Group Art Unit: 3738
	§	
Filed: February 11, 2004	§	Examiner: Ann M. Schillinger
	§	
For: DEVICE FOR FUSING TWO BONE	§	
SEGMENTS	§	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

I. BACKGROUND

The present paper is being filed under the Official Gazette Notice of July 12, 2005 and in response to the final Office action mailed November 8, 2006.

A Notice of Appeal and a Request for a One-Month Extension of Time, each with the proper fee, are being filed concurrently with this paper. It is assumed that no additional fees are required, but if any additional fees are required, the Commissioner is hereby authorized to charge any fees, including those for an extension of time, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

II. REASONS

In the final Office action mailed November 8, 2007, claims 1-22 were pending and under consideration. Claims 1-22 were rejected.

Independent claim 1, 13, and 19 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,591,235 to Kuslich ("Kuslich"). It is respectfully submitted that there are clear errors with the Examiner's rejection of the claims. More specifically, and as described below, the grounds for rejection are clearly legally deficient because the asserted prior art lacks essential elements needed to establish a prima facie rejection with respect to each claim.

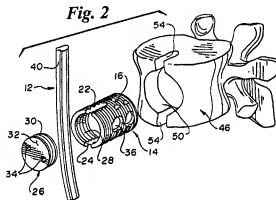
The PTO specifies in MPEP §2131 that, to anticipate a claim, a reference must teach each and every element recited in the claim. Kuslich fails to disclose the recited claim elements.

A. Independent Claim 1

1. “a first transverse plate” and “a second transverse plate”

A first clear error is that the limitations of “a first transverse plate” and “a second transverse plate” as required by independent claim 1 are missing from Kuslich.

The Examiner has taken the position that the combination of the hollow cylindrical screw 14 and locking cap 26 disclosed by Kuslich reads on the first and second transverse plates of claim 1. These elements are shown in Fig. 2 of Kuslich, which is reproduced below for ease of reference.



Applicants respectfully traverse the Examiner's position and submit that the noted elements 14, 26, are not “plates” within even the broadest definition of that term. On the contrary, Applicants submit that, at a minimum, an element must be substantially flat on top and bottom opposing sides to constitute a “plate.” For example, one definition of a “plate” provided in Merriam Webster's Online Dictionary (www.m-w.com) is “a smooth flat thin piece of material.” In other words, a “plate,” by definition, is substantially flat. Another common feature of a plate, as that term is commonly understood, is that its “height” is typically smaller than its “length” and “width.” Therefore, under no definition of the term would the cylindrical structures comprising elements 14 and 26 disclosed in Kuslich constitute “plates”. Accordingly, Kuslich clearly fails to disclose first and second transverse plates, as required by independent claim 1.

2. “adapted for complete insertion within the intervertebral space”

A second clear error is that the limitation “adapted for complete insertion within the intervertebral space” as required by independent claim 1 is missing from Kuslich. Clearly, the cylindrical screws 14 and end caps 26 of Kuslich are not so adapted.

On the contrary, as clearly illustrated in Fig. 2 above, the element 14 is adapted for insertion within the vertebral body itself; not within the space between the vertebrae (i.e., “the intervertebral space”). Clearly, therefore, Kuslich fails to teach “first and second transverse plates . . . adapted for

complete insertion within the intervertebral space,” as required by claim 1. Moreover, the element 26 is not “adapted for insertion” at all; it remains on the exterior of the vertebral body.

Accordingly, Kuslich clearly fails to disclose first and second transverse plates “adapted for complete insertion within the intervertebral space” as required by independent claim 1.

B. Independent Claims 13 and 19

Claims 13 and 19 include limitations similar to those of claim 1 and are therefore also not anticipated by Kuslich for at least the reasons set forth above.

C. Dependent Claims

Claims 2-12, 13-18, and 20-22 depend from and further limit claims 1, 13, and 19, and are therefore also not anticipated by Kuslich for at least the reasons set forth above.

III. CONCLUSION

Applicants have therefore demonstrated that at least two clear legal deficiencies exist in the Examiner's position. Consequently, the rejections are clearly not proper and are without basis and it is therefore respectfully requested that the rejections of all of the claims be withdrawn.

Respectfully submitted,


Brandi W. Sarfatis
Registration No. 37,713

Dated: 3/5/07

HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 214/651-5896
Facsimile: 214/200-0948

Certificate of Transmission

I hereby certify that this correspondence is being transmitted via EFS-Web to the United States Patent and Trademark Office, on the date indicated below

Date: March 5, 2007

By - Printed Name: Debbie Ludwig

Signature: Debbie Ludwig